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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
	:	
Masaaki TAKAMIYA	:	Confirmation Number: 5295
	:	
Application No.: 10/711,296	:	Group Art Unit: 2178
	:	
Filed: September 9, 2004	:	Examiner: O. Abdul-Ali
	:	
For: SYSTEMS, METHODS, AND COMPUTER READABLE MEDIA FOR CONSISTENTLY RENDERING USER INTERFACE COMPONENTS		

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed September 12, 2008, wherein Appellant appeals from the Examiner's rejection of claims 1, 3-7, 9-13, and 15-18.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on September 9, 2004, at Reel 015096, Frame 0048.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1, 3-7, 9-13, and 15-18 are pending and three-times rejected in this Application. Claims 2, 8, and 14 have been cancelled. It is from the multiple rejections of claims 1, 3-7, 9-13, and 15-18 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Third and Final Office Action dated June 12, 2008 (hereinafter the Third Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

1   Referring to Figure 3 and also to independent claim 1, a system for software instructions

2   to display a user interface according to user interface properties carried in a style sheet is

3   disclosed, and the system include a client machine 305 and processor. The client machine 305

4   retrieves the style sheet 325 having user interface properties (lines 2 and 8 of paragraph [0040];

5   lines 7-14 of paragraph [0042]); (ii) retrieves software instructions 320 to be executed on the

6   client machine 305 (lines 1-4 of paragraph [0040]); and (iii) retrieves a script 315 for providing

7   said software instructions 320 access to the style sheet 325 (lines 7-11 of paragraph [0043]). The

8   processor executes the software instructions 320 on the client machine 305 (lines 1-7 of

9   paragraph [0040]), and the software instructions 320 call the script 315 to retrieve user interface

10   properties (lines 11-12 of paragraph [0044]). The software instructions 320, when executed,

11   display a user interface screen 360 in accordance with the retrieved user interface properties

12   (lines 1-4 of paragraph [0053]). The software instructions 320 are disposed in a Java applet

13   (lines 3-6 of paragraph [0040]).

1   Referring to Figure 5 and also to independent claim 7, a method for software instructions

2   to display a user interface according to user interface properties carried in a style sheet is

3   disclosed. In step 510, the style sheet having user interface properties is retrieved (lines 5-7 of

4   paragraph [0055]). In step 520, software instructions to be executed on a client machine are

5   retrieved (lines 8-9 of paragraph [0055]). In step 525, a script for providing said software

6   instructions access to the style sheet is retrieved (lines 9-11 of paragraph [0055]). In step 530,

7   the software instructions are executed on the client machine, and the software instructions call

8   the script to retrieve user interface properties (lines 1-4 of paragraph [0053]; lines 3-4 of

9   paragraph [0056]). In step 550, the software instructions, when executed, display a user interface

10   screen in accordance with the retrieved user interface properties (lines 1-4 of paragraph [0053];

11   lines 4-5 of paragraph [0056]). The software instructions are disposed in a Java applet (lines 3-6

12   of paragraph [0040]).

13   Referring to Figure 5 and also to independent claim 13, a computer readable medium

14   whose contents cause a computer system to display a user interface according to user interface

15   properties carried in a style sheet is disclosed. The computer system performs the following

16   steps. In step 510, the style sheet having user interface properties is retrieved (lines 5-7 of

17   paragraph [0055]). In step 520, software instructions to be executed on a client machine are

18   retrieved (lines 8-9 of paragraph [0055]). In step 525, a script for providing said software

19   instructions access to the style sheet is retrieved (lines 9-11 of paragraph [0055]). In step 530,

20   the software instructions are executed on the client machine, and the software instructions call

21   the script to retrieve user interface properties (lines 1-4 of paragraph [0053]; lines 3-4 of

22   paragraph [0056]). In step 550, the software instructions, when executed, display a user interface

23   screen in accordance with the retrieved user interface properties (lines 1-4 of paragraph [0053];

1 lines 4-5 of paragraph [0056]). The software instructions are disposed in a Java applet (lines 3-6

2 of paragraph [0040]).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 3-7, 9-13, and 15-18 were rejected under 35 U.S.C. § 103 for obviousness

based upon Saidenberg et al., U.S. Patent Publication No. 2004/0003347 (hereinafter

Saidenberg), in view of Michael Kay, "Using Stylesheets" (hereinafter Kay).

VII. ARGUMENT

1   **THE REJECTION OF CLAIMS 1, 3-7, 9-13, AND 15-18 UNDER 35 U.S.C. § 103 FOR**

2   **OBVIOUSNESS BASED UPON SAIDENBERG IN VIEW OF KAY**

3   For convenience of the Honorable Board in addressing the rejections, claims 3-7, 9-13,

4   and 15-18 stand or fall together with independent claim 1.

5

6   Appellant has compared the statement of the rejection found on pages 2-5 of the Third

7   Office Action with the statement of the rejection found on pages 2-5 of the Third Office Action.

8   Upon making this comparison, Appellant has been unable to discover any substantial differences

9   between the respective statements of the rejection. As such, Appellant proceeds on the basis that

10   the Examiner's sole response to the arguments presented in Appellant's Second Response dated

11   February 1, 2008 (hereinafter the Second Response) is found on page 5 of the Third Office

12   Action in the section entitled "Response to Arguments."

13

14   Obviousness is a legal conclusion based on underlying facts of four general types, all of

15   which must be considered by the trier of fact: (1) the scope and content of the prior art; (2) the

16   level of ordinary skill in the art; (3) the differences between the claimed invention and the prior

17   art; and (4) any objective indicia of nonobviousness.[1] On page 3 of the Second Office Action,

18   the Examiner asserted that "Saidenberg ... does not explicitly disclose the software instructions

19   are disposed in a Java applet." In this regard, Appellant respectfully submits that the Examiner

20   has failed to properly characterize the differences between the claimed invention and the prior

---

[1] See KSR Int'l v. Teleflex Inc., 550 U.S. ___ (2007); Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966);
Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750-51 (Fed. Cir. 1991);
Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566-68, 1 USPQ2d 1593, 1594 (Fed. Cir. 1987).

1 art. As previously argued on page 9 of the First Response dated August 14, 2007 (hereinafter the

2 First Response), the Examiner has not factually established that the software instructions in

3 Saidenberg, which are in a Java applet, also call a script to retrieve user interface properties.

4 Instead, Saidenberg teaches that HTML pages use a script to access a style sheet file.

5

6 The above-reproduced arguments (incorporated herein) were originally presented in the

7 paragraph spanning pages 2 and 3 of the Second Response. The Examiner's response to these

8 arguments is found on page 5 of the Third Office Action in which the Examiner asserted the

9 following:

10 Claims 1, 7, and 13: Applicant argues, "The Examiner has not factually established that the
11 software instructions in Saidenberg also call a script to retrieve user interface properties." It is
12 respectfully submitted that Saidenberg discloses the limitation as claimed above. Saidenberg
13 discloses software instructions, which broadly interpreted may be a browser for instance. The
14 software instructions in Saidenberg include a javascript file which identifies which stylesheet to
15 load in the application.
16
17 The Examiner's "new" analysis ignores the Examiner's other analysis presented in the Second

18 Office Action and repeated on page 2 of the present Third Office Action. Specifically, on page 2

19 of the Third Office Action, the Examiner asserted the following:

20 retrieving software instructions(sequences of instructions) to be executed on a client machine
21 (page 5, paragraph 48).
22

23 The portion of paragraph [0048] of Saidenberg apparently being referred to is the

24 following passage:

25 The web browser may also run or execute programs, such as Java applets including sequences of
26 instructions provided in accordance with the Java programming language, or JavaScript.
27
28 Based upon the Examiner's initial analysis, the Examiner appears to be asserting that the claimed

29 "software instructions" are taught by the "Java applets including sequences of instructions"

1   described by Saidenberg. This initial analysis, however, is <u>inconsistent</u> with the Examiner's new

2   analysis that "software instructions, which broadly interpreted may be a browser."

3

4   The Examiner "new" analysis also presents an inconsistency when reviewing all of the

5   claimed limitations. As claimed, the "software instructions [are] to be executed on the client

6   machine," and "the software instructions are disposed in a Java applet." Referring to the cited

7   portion of paragraph [0048] reproduced above, the web browser taught by Saidenberg executes

8   programs, such as Java applets. However, by construing the software instructions to be "a

9   browser for instance," the Examiner analysis yields the incongruous result that the web browser

10   of Saidenberg (which is taught as executing programs) would execute itself.

11

12   Appellant's position is that the Examiner's claim construction is not consistent with the

13   ordinary and customary meanings that these terms would have to one having ordinary skill in the

14   art. Specifically, one having ordinary skill in the art would not have interpreted the browser of

15   Saidenberg to be comparable to the claimed software instructions. Instead, one having ordinary

16   skill in the art would have recognized that the "Java applets including sequences of instructions"

17   taught by Saidenberg is comparable to the claimed "software instructions to be executed on the

18   client machine" and "the software instructions are disposed in a Java applet." Moreover,

19   consistent with both the teachings of Saidenberg (see the portion of paragraph [0048] reproduced

20   above) and Appellant's specification (see Fig. 3 showing the Java applet 320 within the browser

21   310), the web browser executes the software instructions (i.e., the Java applet).

22

1   Therefore, for the reasons stated above, Appellant maintains that the Examiner has

2   mischaracterized the scope and content of the teachings of Saidenberg.

3

4   _____

5   Regarding the claimed "executing said software instructions ..." limitation found in claim

6   1, the Examiner cited paragraph [0100] of Saidenberg. However, as recited in each of

7   independent claims 1, 7, and 13, this execution is performed in the client machine. However,

8   paragraph [0100] of Saidenberg refers to the customization module 302, which is shown in Fig. 1

9   as being disposed in the server system 101. This cited passage also refers to applications 450,

10   also shown in Fig. 1, are run on the server system 101. Thus, these limitations do not relate to

11   the client machine (allegedly disclosed by features 102 of Saidenberg). Therefore, the Examiner

12   has further mischaracterized the teachings of the applied prior art.

13

14   _____

15   On page 3 of the Second Office Action, the Examiner further asserted the following

16   regarding Kay:

17   Kay discloses a similar system for displaying a user interface according to user interface properties
18   carried in a style sheet that further discloses using instructions disposed in a Java applet that apply
19   a given style sheet to an XML document (page 5). Therefore, it would have been obvious to one
20   having ordinary skill in the art at the time the invention was made to dispose the software
21   instruction that access a style sheet in Saidenberg. One would have been motivated to dispose the
22   instructions in a Java applet in order to save resources on the server by performing the instructions
23   on the client machine.
24
25   Appellant notes that the Examiner has again mischaracterized the teachings of the applied prior

26   art. Kay does not disclose a similar system to that described by Saidenberg or the claimed

27   invention. Instead, Kay is simply a reference as to how to use a particular type of stylesheet in

28   either a command line, a Java API, or as an Applet in a browser.

1

2   The above-reproduced arguments (incorporated herein) were originally presented in the

3 paragraph spanning page 3 of the Second Response. The Examiner's response to these

4 arguments is found on page 5 of the Third Office Action in which the Examiner asserted the

5 following:

6   The Kay reference is relied upon to teach the limitation of when the software instructions are
7   disposed in a Java applet. Kay is similar in the sense that it is a system which uses a Java Applet to
8   call a stylesheet in a browser. In response to applicant's argument that the Examiner's asserted
9   benefit for the combination is factually unsupported, the applicant is directed to the motivation
10   provided by Kay, "the transformation will run on the client machine, which saves resources on the
11   server, " and the fact that applicant has recognized another advantage which would flow naturally
12   from following the suggestion of the prior art cannot be the basis for patentability when the
13   differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. &
14   Inter. 1985).
15
16 Yet again, the Examiner's analysis is flawed. On one hand, the Examiner is asserting that the

17 browser of Saidenberg corresponds to the claimed software instructions, and on the other hand,

18 the Examiner is asserting that "Kay reference is being relied upon to teach the limitation of when

19 the software instructions are disposed in a Java applet." As Appellant already noted above, the

20 primary reference of Saidenberg already clearly and unambiguously teaches software

21 instructions being disposed in a Java applet. Thus, the Examiner's secondary reference is

22 superfluous.

23

24   Notwithstanding the apparent superfluous citation of Kay, the Examiner's proposed

25 modification would involve wastefulness and convoluted modifications of the type found in a

26 Rube Goldberg contraption. To modify Saidenberg in view of Kay would involve replacing the

27 browser of Saidenberg (i.e., allegedly disclosing the claimed software instructions) with the Java

28 applet of Kay. However, since the web browser is taught by Saidenberg as executing the Java

29 applet, Saidenberg would have to be modified again to include a web browser. However, some

1   of the functions attributed to the prior web browser (i.e., calling the script to retrieve user

2   interface properties) would remain with the Java applet of Kay, and other properties of

3   Saidenberg associated with the web browser (i.e., executing the Java applet) would be included

4   in the new browser. Thus, without any guidance from the applied prior art, the Examiner is

5   alleging that one having ordinary skill in the art would have been realistically impelled to (i)

6   replace a browser with a Java applet; (ii) reintroduce the browser (in order to execute the Java

7   applet); (iii) take certain functions from the old browser and give these new functions to the Java

8   applet; and (iv) take other functions from the old browser and give these new functions to the

9   new browser.

10

11   Appellant's position is that the Examiner's proposed modification based upon the

12   teachings of Saidenberg and Kay ignores the teachings of Saidenberg, as a whole, and the

13   obvious result of the combination of these two references. Specifically, Saidenberg teaches that

14   "web browser may also run or execute programs, such as Java applets," and to modify

15   Saidenberg to include the Java applet of Kay would simply involve having the web browser of

16   Saidenberg execute the specific Java applet (i.e., "Saxon") described by Kay. The reason why

17   the Examiner's analysis goes down this path is because the obvious combination of Saidenberg

18   and Kay does not result in the claimed invention. Specifically, neither Saidenberg nor Kay,

19   alone or in combination, teach that the software instruction, which are in a Java applet, call a

20   script to retrieve user interface properties. As such, to arrive at the claimed invention, the

21   Examiner has been forced to mischaracterize the teachings of Saidenberg and allege the

22   obviousness of non-intuitive modifications to the applied prior art.

23

1

2 Although not explicitly stated, the Examiner appears to be employing the "Teaching,

3 Suggestion, or Motivation in the Prior Art" rationale described in the "Examination Guidelines

4 for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in

5 KSR International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007). The Examination

6 Guidelines, with regard to Rationale G (i.e., "Some Teaching, Suggestion, or Motivation in the

7 Prior Art That Would Have Led One of Ordinary Skill To Modify the Prior Art Reference or To

8 Combine Prior Art Reference Teachings To Arrive at the Claimed Invention") states that

9 following findings of fact <u>must</u> be articulated by the Examiner:

10   (1) a finding that there was some teaching, suggestion, or motivation, either in the
11 references themselves or in the knowledge generally available to one of ordinary skill in the art, to
12 modify the reference or to combine reference teachings;
13   (2) a finding that there was reasonable expectation of success; and
14   (3) whatever additional findings based on the Graham factual inquiries may be necessary,
15 in view of the facts of the case under consideration, to explain a conclusion of obviousness.
16

17 Entirely absent from the Examiner's analysis, however, is a finding that there was a reasonable

18 expectation of success.

19

20 <u>Conclusion</u>

21 Based upon the foregoing, Appellant respectfully submits that the Examiner's rejection

22 under 35 U.S.C. § 103 based upon the applied prior art is not viable. Appellant, therefore,

23 respectfully solicits the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 12, 2008

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. A system for software instructions to display a user interface according to user interface properties carried in a style sheet, the system comprising:

a client machine for:

retrieving the style sheet having user interface properties;

retrieving software instructions to be executed on the client machine; and

retrieving a script for providing said software instructions access to the style sheet; and

a processor for executing said software instructions on the client machine, said software instructions calling the script to retrieve user interface properties, said software instructions, when executed, displaying a user interface screen in accordance with the retrieved user interface properties, wherein

the software instructions are disposed in a Java applet.

3. The system of claim 1 wherein the script is a Javascript.

4. The system of claim 3 wherein the Java applet utilizes a Java-Javascript API to call the Javascript.

5. The system of claim 1 further comprising:

a portal application server for delivering the style sheet, the script, and the software instructions.

6. The system of claim 5 wherein the portal application server generates HTML having user interface components and associates the generated HTML with the style sheet, the system further comprising:

a browser for displaying the user interface components according to the style sheet.

7. A method for software instructions to display a user interface according to user interface properties carried in a style sheet, the method comprising:

retrieving the style sheet having user interface properties;

retrieving software instructions to be executed on a client machine;

retrieving a script for providing said software instructions access to the style sheet; and

executing said software instructions on the client machine, said software instructions calling the script to retrieve user interface properties, said software instructions, when executed, displaying a user interface screen in accordance with the retrieved user interface properties, wherein

the software instructions are disposed in a Java applet.

9. The method of claim 7 wherein the script is a Javascript.

10. The method of claim 9 wherein the Java applet utilizes a Java-Javascript API to call the Javascript.

11. The method of claim 7 further comprising:

delivering the style sheet, the script, and the software instructions from a portal application server.

12. The method of claim 11 wherein the portal application server generates HTML having user interface components and associates the generated HTML with the style sheet, the method further comprising:

displaying the user interface components according to the style sheet.

13. A computer readable medium whose contents cause a computer system to display a user interface according to user interface properties carried in a style sheet, the computer system performing the steps of:

retrieving the style sheet having user interface properties;

retrieving software instructions to be executed;

retrieving a script for providing said software instructions access to the style sheet; and

executing said software instructions, said software instructions calling the script to retrieve user interface properties, said software instructions, when executed, displaying a user interface screen in accordance with the retrieved user interface properties, wherein

the software instructions are disposed in a Java applet.

15. The computer readable medium of claim 13 wherein the script is a Javascript.

16. The computer readable medium of claim 15 wherein the Java applet utilizes a Java-Javascript API to call the Javascript.

17. The computer readable medium of claim 13 further comprising:

delivering the style sheet, the script, and the software instructions from a portal application server.

18. The computer readable medium of claim 17 wherein the portal application server generates HTML having user interface components and associates the generated HTML with the style sheet, the computer readable medium further comprising:

displaying the user interface components according to the style sheet.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.